

REMARKS

Claims 1-4 and 6-20 are pending in this application. Claims 11-20 stand withdrawn. By this Amendment, claim 5 is canceled without prejudice to or disclaimer of the subject matter recited therein. Claim 1 is amended to incorporate the subject matter of canceled claim 5. Thus, no new matter is added.

Entry of the amendments is proper under 37 C.F.R. §1.116 since the amendments: (a) place the application in condition for allowance for the reasons discussed herein; (b) do not raise any new issue requiring further search and/or consideration since the amendments amplify issues previously discussed throughout prosecution; and (c) place the application in better form for appeal, should an appeal be necessary. Entry of the amendments is thus respectfully requested.

I. Withdrawn Claims

Rejoinder and examination of claims 11-20 is requested. Claims 11-19 recite a method of assembling a lead wire of a starter and therefore are sufficiently related to elected claims 1-10, which also recite a method of assembling a lead wire of a starter, that a search of a different subclass within the same class is not a serious burden to the Examiner. Furthermore, a search for the subclass of claim 20 is not a serious burden as it too is the same class as claims 1-19.

II. Claim Rejections Under 35 U.S.C. §102

Claims 1 and 4-10 are rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent 5,309,054 to Yamamoto et al. As claim 5 is canceled, the rejection of that claim is moot. The rejection of claims 1, 4 and 6-10 is respectfully traversed.

Yamamoto fails to disclose each and every feature recited in the rejected claims, as amended. For example, Yamamoto fails to disclose a method of assembling a lead wire of a

starter comprising steps of: bending a lead wire for connecting a starting motor and a magnet switch to form a first bent portion and a second bent portion; integrally molding a sleeve with the lead wire so as to tightly fix to the second bent portion of the lead wire; and inserting an end of the sleeve facing to the first bent portion of the lead wire to a housing of the starting motor so as to seal an outer periphery of the sleeve and an insertion portion of the housing, wherein the molding includes forming the sleeve to leave a clearance between the first bent portion of the lead wire and the sleeve.

In rejecting claims 1 and 4-10, the Office Action refers to the prior Office Action mailed on June 9, 2004. In that Office Action, the Examiner alleged that "Fig. 2A shows a sleeve (14) to leave a clearance between the first bent portion of the lead wire and the sleeve" in rejecting the subject matter of claim 5. However, review of Yamamoto reveals that no such feature is disclosed. Rather, Fig. 2A clearly shows a space between the lead wire 21 and an insulation tube 14. Therefore, Yamamoto does not disclose "forming the sleeve to leave a clearance between the first bent portion of the lead wire and a sleeve" as recited in the amended claim. In the pending claim, a sleeve is integrally molded with the lead wire so as to tightly fix to the second bent portion of the lead wire and inserting an end of the sleeve facing the first bent portion of a lead wire to a housing of the starting motor so as to seal and an insertion portion of the housing. Thus, the sleeve recited in the pending claims is tightly fixed to the second bent portion and inserted into the housing of the motor. In Fig. 2A, the insulation tube 14 is not tightly fixed to the second bent portion but rather has a clearance between the insulation tube and the wire. Accordingly, Yamamoto does not disclose forming the sleeve to leave a clearance between the first bent portion of the lead wire and the sleeve as alleged in the Office Action of June 9, 2004. Furthermore, the insulation tube 14 is not inserted into the housing of the motor.

Even were the Examiner to re-interpret Figure 2A to allege that the grommet 13 corresponds to a sleeve tightly fixed to the second bent portion of the lead wire 21, none of the figures, nor any description in the specification, discloses a clearance between the first bent portion of the lead wire and the grommet 13. Thus, Yamamoto fails to disclose each and every feature recited in the rejected claims.

The insertion of the subject matter of claim 5 into claim 1 does not raise new issues that would require further consideration and/or search by the Examiner as the subject matter of claim 5 has at no time been amended and should not have been rejected in the previous Office Action, but rather claim 5 has been found to be allowable. Additionally, as dependent claims incorporate the subject matter of their independent base claims, the claim language of amended claim 1 only reflects that of originally filed claim 5. Therefore, there are no new issues that would require further search and/or consideration. Thus, withdrawal of the rejection of claims 1 and 4-10 is respectfully requested.

III. Claim Rejections Under 35 U.S.C. §103

Claims 2 and 3 are rejected under 35 U.S.C. §103(a) as unpatentable over Yamamoto in view of JP 3009069 to Hasegawa. The rejection is respectfully traversed.

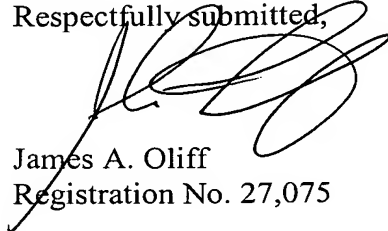
Claims 2 and 3 are allowable for their dependency on independent claim 1 for the reasons discussed above, as well as for the additional features recited therein. Accordingly, withdrawal of the rejection of claims 2 and 3 is respectfully requested.

IV. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-4 and 6-20 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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